

## REMARKS

Claims 15-51 are pending. Claims 33-42 are withdrawn. Claims 15 and 23 are currently amended. Claims 43-51 are added.

### Provisional Election Affirmed

Claims 15-42 are subject to restriction under 35 U.S.C. §121. Restriction between two groups of claims was required. Applicants affirm the provisional election made with traverse to prosecute Group I (claims 15-32).

### Rejections under §103 Moot or Traversed

Independent claims 15 and 23 stand rejected under 35 U.S.C. 103(a) as being allegedly obvious over U.S. Patent No. 4,656,059 to Mizuno et al, however, in view of the above amendments, the rejection is now moot.

The Mizuno reference depends on the presence of melamine-aldehyde acid colloid solution. *See* col. 5, lines 34-38. It teaches that "surface active agent" may be used *additionally*, but requires the presence of melamine-aldehyde acid colloid solution. For example, the Mizuno reference states that "[t]he amount of the surface active agent to be properly used is in the range of 0.01 to 1 part by weight, based on 1 part *by weight of the melamine-aldehyde acid colloid solution*" (emphasis added; col. 4, lines 8-11). In contrast, Applicants have discovered that excellent results can be achieved using dispersants (and pH adjusters) by themselves.

Applicants have amended the above independent claims to better define the invention, and submit that they are now in condition for allowance. Dependent claims 16-19 and 24-32 depend from and further limit their respective independent claims, and therefore are allowable as well.

Independent claim 20 stands rejected under 35 U.S.C. 103(a) as being allegedly obvious over a combination of U.S. Patent No. 4,656,059 to Mizuno et al. and U.S. Patent No. 6,187,195 to Zarges et al. Applicants respectfully traverse the rejection, as a *prima facie* case of obviousness has not been established for claim 20.

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PATENT

As discussed in MPEP § 2143.01, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine reference teachings. However, nothing in the Zarges reference suggests the combination. The Zarges reference is limited to adding polyaspartic acid to inhibit scale formation on membrane filters. Scaling is defined in the Zarges reference as "the encrustation of the membrane by inorganic salts as a result of exceeding their solubility limit" (col. 1, lines 50-51). No mention is made of paint.

In contrast to the above described solubility driven salt precipitation, the Mizuno reference teaches that paint collects because it has high tackiness (col. 1, lines 26-28). It does not address scaling, or even problems associated with membrane filtration. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the *desirability* of the combination. MPEP §2143.01. Thus, since neither reference teaches towards a combination, there is no permissible reason to combine the references.

Dependent claims 21-23 depend from and further limit an allowable independent claim, and therefore are allowable as well.

If the Examiner has any questions, the Examiner is invited to call the undersigned at (215) 557-5997.

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